

REMARKS

Claims 1-30 are in this case.

Claims 3-9 are rejected under 35 U.S.C. §112.

5 Claims 1-2 and 27-30 are rejected under 35 U.S.C. §102(b).

Claims 1-26 are rejected under 35 U.S.C. §103(a).

Claims 1, 3-5, 7 and 11 are amended.

Claim 31 was previously cancelled.

Please cancel claims 12-19 and 27-30.

10 New claims 32-44 are entered.

In a telephone conversation with the examiner on June 26, 2006, the Examiner confirmed that the drawing and specification objections indicated in the Office Action Summary are in error.

Claims 3 and 4 have been amended to overcome the Examiner's §112 rejection. Specifically, the term "wire" in claim 3 has been amended to read --elongate element-- and the term "springy post" in claim 4 has been amended to read --post--. Claims 5, 7 and 11 have also been amended to read --elongate element-- instead of "wire". The Applicant respectfully suggests that these amendments do not introduce new matter into the application. The Examiner's rejections under §112 are moot in view of these amendments.

20 Claim 1 has been amended to specify that the heated elongate element does not burn skin. Support for this amendment is found in the specification on page 2, lines 7-13; page 8, lines 34-37 and page 9, lines 8-19.

The amendment to claim 1 serves to overcome the Examiners rejection of claims 1 and 2 as being anticipated by JP 01288291 under §102(b). JP 01288291 discloses heating of conductive ceramic material in a surgical cutting tool specifically for the purpose of cutting/burning skin. Modification of the device pictured in Fig. 3 of JP 1-288291 to provide only hair cutting as instantly claimed would render it unfit for its intended purpose as a surgical tool.

The Examiner has also asserted that claims 27-30 are anticipated by US 1744525 (hereinafter Chase) under §102(b). Cancellation of claims 27-30 renders this rejection moot.

30 Claims 1-10 are rejected under §103(a) as being unpatentable over Chase in view of US 2003/0037793 (hereinafter Hwang). New claim 34 corresponds to claim 10. The Applicant respectfully suggests that there is no basis for a §103(a) rejection based upon Chase in view of Hwang.

The Applicant agrees with the Examiner that Chase does not disclose a vibrating structure as instantly claimed in claim 1. The Applicant respectfully refers the Examiner to MPEP 706.02(j) which states that:

5 “The teaching or suggestion to the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant’s disclosure.” and that:

10 “The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. (*Ex parte Clapp*, 227 USPQ 972,973 (*Bd. Pat App & Inter.* 1985)).

Chase does not teach, hint or suggest that addition of a vibrating structure is necessary, desirable, useful or even feasible to implement in the context of the Chase invention. As a result, one of ordinary skill in the art would find no motivation in Chase to embark upon a series of experiments which would lead to implementation of vibration as taught by Hwang.

Even if motivation to combine the teachings of Chase with the teachings of Hwang were present, which it is not, such combination would not produce what is claimed. Hwang teaches a vibrating comb with a stationary coil type heating element. Chase teaches a stationary comb with a stationary heated wire. Combination of Chase and Hwang would produce a device with a vibrating comb and a stationary heated wire “to straighten the hair prior to cutting” as pointed out by the Examiner in the last 3 lines of page 6 of the currently pending office action. Claim 1 as currently before the Examiner is directed towards an apparatus with a vibrating heated element. The Applicant respectfully suggests that there is no basis for a §103(a) rejection based upon Chase in view of Hwang according to the guidelines of MPEP 706.02(j).

Without presenting any additional arguments, claims 2-21 are in condition for allowance at least by virtue of their dependence from claim 1. Nonetheless, the Applicant presents a reasoned rebuttal of all §103(a) rejections of dependent claims set forth by the Examiner in order to expedite prosecution.

30 Claim 10 is rejected under §103(a) as being unpatentable over Chase in view of Hwang and further in view of US 3,925,889 (hereinafter Albert). The Applicant respectfully suggests that the §103(a) rejection of claim 10 is not in accord with the guidelines presented in MPEP 706.02(j) and summarized hereinabove. New claim 34 corresponds to claim 10.

The Applicant refers again to the detailed arguments against combining Chase and Hwang as set forth above. Combination of Chase and Hwang serves only to produce a vibrating comb. With respect to Albert, the Applicant notes that Albert does not disclose a heating element at all. Since the alleged combination of Chase and Hwang produces only a vibrating comb, addition of the Albert reference only serves to produce a comb which vibrates by means of an eccentric rotating weight. Claim 10 is directed towards a heated element which vibrates by means of an eccentric rotating weight. The Applicant respectfully suggests that there is no basis for a §103(a) rejection based upon Chase in view of Hwang and further in view of Albert.

Claims 11-13 and 15-21 are rejected under §103(a) as being unpatentable over Chase in view of Hwang and further in view of US 6,111,222 (hereinafter Hattori). The Applicant respectfully suggests that the §103(a) rejection of claims 11-13 and 15-21 is not in accord with guidelines presented in MPEP 706.02(j) and summarized hereinabove. Claims 12-19 have been cancelled. New claims 33, 35, 36 and 38-44 correspond to previous claims 11-13 and 15-21.

Neither Chase nor Hwang disclose, hint or suggest that a motion detector is necessary, useful, advantageous or even feasible to implement. As a result, one of ordinary skill in the art would have no motivation to seek such a motion detection.

If such motivation existed, which it does not, it would naturally guide the ordinarily skilled artisan to search in the field of vibrating combs which are the only possible result of combining Chase and Hwang. The Hattori reference is from a completely different field of art which does not include combs and is not concerned with hair removal or personal hygiene.

Despite the Examiner's observation that a soldering iron heats to a temperature which can burn hair and the Examiner's statement that "soldering irons and handheld thermal cutters constitute analogous art", the Hattori patent is in a different US class and a different International class than the Hwang patent. The Applicant maintains that one of ordinary skill in the art would not have become aware of the Hattori reference and that the Examiner was motivated to search for Hattori in a disparate class solely because of the Applicant's inventive disclosure.

Even if there were motivation to combine Chase with Hwang and Hattori, which there is not, combination of these three references would still not provide a structure adapted for placement against the skin in an area where hair is to be cut so that the skin is not burned by the elongate element. This is because Hattori a heating element provided in a soldering tool specifically for the purpose of burning metal by direct contact. Modification of the device of Hattori by introduction of the instantly claimed structure for placement against the skin would

render the Hattori device unfit for its intended purpose as a soldering iron. The Applicant respectfully suggests that there is no basis for a §103(a) rejection based upon Chase in view of Hwang and further in view of Hattori.

5 Claim 14 is rejected under §103(a) as being unpatentable over Chase in view of Hwang and further in view of US 6,032,365 (hereinafter Hodges). The Applicant respectfully suggests that the Examiner has not presented a case for a §103(a) rejection based upon guidelines presented in MPEP 706.02(j) and summarized hereinabove. Claim 14 has been cancelled. New claim 37 corresponds to previous claim 14.

10 As explained in detail above, combination of Chase and Hwang would not produce an apparatus with a vibrating heated element as instantly claimed. Even if motivation to combine Hodges with Chase and Hwang existed, which it does not, the Hodges patent discloses a "slotted rotary shaver" which does not employ a heated element to cut hair. Addition of an indicator light as taught by Hodges to Chase and Hwang would not cause the heated element to vibrate as instantly claimed. The Applicant respectfully suggests that a §103(a) rejection based upon Chase in view of Hwang and further in view of Hodges is without merit.

15 Claims 22-26 are rejected under §103(a) as being unpatentable over Chase in view of Hwang and further in view of US 5,606,798 (hereinafter Kelman). The Applicant respectfully suggests that the Examiner has not presented a *prima facie* case for a §103(a) rejection based upon guidelines presented in MPEP 706.02(j) and summarized hereinabove.

20 Once again, combination of Chase and Hwang would not cause vibration of a heated element as instantly claimed. Even if motivation to combine Hodges with Chase and Kelman existed, which it does not, the Kelman patent discloses an apparatus which employs a laser beam to cut hair. Addition of means to gather cut hair in a receptacle as taught by Kelman to Chase and Hwang would not cause the heated element to vibrate as instantly claimed. The Examiner has not presented a *prima facie* case for a §103(a) rejection based upon Chase in view of Hwang and further in view of Hodges.


25 Applicants submit that claims 1-11; 20-26 and 32-44 as currently before the Examiner are in condition for allowance.

Prompt notice of allowance is earnestly and respectfully requested. If, however, the Examiner is of the opinion that a telephone conversation may forward the present application toward allowance, Applicants respectfully request that the Examiner call the undersigned at 1 (877) 428-5468. Please note that this is a direct *toll free* number in the US that is answered in the undersigned's Israel office. Israel is 7 hours ahead of Washington.

Respectfully submitted,

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August 2, 2006

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